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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,793	05/28/2004	Rajagopal Andra	BUR920040087US1	3792
29154	7590	03/18/2008		
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ANNAPOLIS, MD 21401				
EXAMINER				
DWTIVEDI, MAHESH H				
ART UNIT		PAPER NUMBER		
2168				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/709,793

Applicant(s)

ANDRA ET AL.

Examiner

MAHESH H. DWIVEDI

Art Unit

2168

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6, 8-16 and 18-24.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Tim T. Vo/
Supervisory Patent Examiner, Art Unit 2168

Mahesh Dwivedi
Patent Examiner, AU 2168
3/13/08

Continuation of 11, does NOT place the application in condition for allowance because: Applicants request for reconsideration filed on 02/28/2008 is acknowledged, but is not persuasive. Applicants argue on pages 10-11 that "The present invention defines a "static structure" as a "pre-built XML structure with pre-filled values based on the associated transaction type and TPP". Therefore, the pre-built XML "static structures" of the present invention are static, i.e., unchanging, and pre-filled with values based on the associated transaction type and trading partner profile. Hence, there are no negotiable fields in the static structures with pre-filled values of the present invention because the structures are static and pre-filled. In contrast, the contract template of Dan contains one or more negotiable fields 1023, 1024 that will be filled with future negotiations. Therefore, Applicants respectfully submit that Dan does not disclose, teach or suggest the present invention's feature of "pre-building static structures of said XML transaction, wherein said static structures comprise...as recited in independent claims 1, 11, and 21". However, the examiner wishes to refer to paragraphs 33-34 of Dan which state "The profile serves as the starting point of a negotiation by providing an initial version of a contract document" (Paragraph 33), "The profile may be expressed, for example, as an XML document whose contents may be incorporated into a contract" (Paragraph 34), and "One example of a contract template is an almost-complete electronic contract document with a few fields left blank" (Paragraph 34). The examiner further wishes to state that independent claims merely state "pre-building static structures of said XML transaction". The examiner further wishes to state that Dan is used to only teach the aforementioned limitation, and that Albazz is used to teach the "wherein said static structures comprise...transaction type" limitation. Applicant argues on page 12 that "However, the DTD of the present invention is originally fixed and its DTD copied, and does not require slight modifications or amending of element type declarations as does Thomas because the final XML structure of the present invention comprises pre-filled static structures, to which no modifications or amendments of the DTD are made...so that the final or constructed XML structure may be compared to or validated against the original pre-defined data type definition". However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "does not require slight modifications or amending of element type declarations") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicants argue on pages 13-14 that "The static and dynamic product lists of Albazz are not explicitly defines as XML data structures corresponding to a transaction. A list is not a transaction". However, the examiner wishes to refer to paragraphs 40-42 of Albazz which state "Non-negotiable elements include the lower six blocks in the diagram, which represent names, profiles, audience, approvals, and any standard contractual text. All other elements are classified as negotiable elements. All non-negotiable elements can be easily collected and managed over an Internet (preferably World Wide Web) based collaborative environment maintained by the seller organization that offers two main features: 1. Data entry and update web pages for collecting and maintaining trading partner profiles and any other information pertaining to personnel or resources that need to be referenced in a contract; and 2. A non-structured text editor which supports HTML or a like format, preferably XML/XSL, and preferably also supports document versions" (Paragraphs 40-42). The examiner further wishes to refer to Paragraphs 55 and 68 of Albazz which state "the preferred embodiment of the invention provides for the creation of many different Ts&Cs Sets using the Business Rules Book. Each Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations. In a marketplace, different Ts&Cs Sets created by a supplier can be used by the e-commerce site to respond to a request for quotation (RFQ) from a buyer either by automatic rating and matching of the request or by pre-assigning a Ts&Cs Set to the buyer" (Paragraph 55) and "During the contract negotiation process the seller may decide to switch into a more attractive Ts&Cs Set, to overcome buyer reluctance or a competitive offer and win the buyer's business. This is readily done by simply referencing a different Ts&Cs Set identifier or reference number in the proposed contract or in response to an RFQ. Once a contract is approved and signed by the buyer, a copy of the selected Ts&Cs Set becomes an integral part of that contract. A contract may only include one Ts&Cs Set" (Paragraph 68). The examiner further wishes to state that the contract of Albazz is clearly a data structure that corresponds to a business transaction. Applicants argue on Page 14 that "Albazz also does not disclose, teach, or suggest the present invention's feature of "pre-building static structures of said XML transaction...Instead, merely discloses generating a list that could be static with the same products being produced at every run, or could be dynamic with new products being added or removes according to changes taking place at the seller organization". However, the examiner wishes to state that Dan teaches the "pre-building static structures limitation and that Albazz teaches the "wherein said static structures...profile" limitation. Moreover, the examiner further wishes to refer to Paragraphs 55 and 68 of Albazz which state "the preferred embodiment of the invention provides for the creation of many different Ts&Cs Sets using the Business Rules Book. Each Ts&Cs Set represents an integrated set of terms and conditions which can be used selectively by the sales group to prepare and propose contracts to prospective buyer organizations. In a marketplace, different Ts&Cs Sets created by a supplier can be used by the e-commerce site to respond to a request for quotation (RFQ) from a buyer either by automatic rating and matching of the request or by pre-assigning a Ts&Cs Set to the buyer" (Paragraph 55) and "During the contract negotiation process the seller may decide to switch into a more attractive Ts&Cs Set, to overcome buyer reluctance or a competitive offer and win the buyer's business. This is readily done by simply referencing a different Ts&Cs Set identifier or reference number in the proposed contract or in response to an RFQ. Once a contract is approved and signed by the buyer, a copy of the selected Ts&Cs Set becomes an integral part of that contract. A contract may only include one Ts&Cs Set" (Paragraph 68). The examiner further wishes to state that Albazz's multiple pre-built T&C sets that users can choose from broadly teach the aforementioned limitations.